

### **Remarks**

Reconsideration of this application and entry of the amendments above are respectfully requested. It is believed that the amendments place the present application in condition for allowance or at least in better condition for appeal.

#### **I. Status of the Claims**

Claims 29 to 41 were pending in the present application. Claims 29-38 and 40 to 41 were rejected. Claim 39 was objected to as being dependent on a rejected base claim. Claims 29, 33, and 40 have been amended. Presently, Claims 29 to 41 are under consideration in the present application.

Claim 29 has been amended to state that "said peptide optionally contains a detectable label." Support for this amendment is found in the specification as originally filed at page 12, line 32.

Claim 33 has been amended to delete the element "arginine" from the Markush group for R<sup>10</sup>; deletion of which does not add new matter to the present application.

Claim 40 has been amended to specify that a detectably labeled peptide of Claim 29 is employed and that the ability of the compound to inhibit binding of the labeled peptide is measured by measuring the change in detectable label.

#### **II. Sequence Listing**

The enclosed sequence listing corrects defects in the original sequence listing with respect to SEQ ID NOs: 32 and 34. SEQ ID NO: 32 contains a typographical error in the descriptor of position-3, in particular, "Xa" should read "Xaa." SEQ ID NO: 34 has been amended to correctly identify the modified residue as being D-citrulline, as identified in Tables 5 and 6 on page 29 of the specification as originally filed. These corrections of typographical errors do not add new matter to the present application.

The changes to the sequence listing are summarized as follows:

SEQ ID NO: 32: Spelling of "Xaa" of position 3 is corrected; and

SEQ ID NO: 34: Stereochemistry of the amino acid of position 1 (D-citrulline) is corrected.

#### **III. Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 29-33, 35-37 and 40-41 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner noted that the claims include a substituent which is not a detectable label and the structure of the substituent is not defined in the specification. Applicant has amended Claim 29, from which Claims 30-33, 35-37 and 40-41 directly or indirectly depend, to state that "said peptide optionally contains a detectable label". This language clarifies that the peptide can optionally contain a detectable label. In view of this amendment and the remarks above, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 29-33, 35-37, and 40-41 under 35 U.S.C. § 112, first paragraph.

#### **IV. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 33, 38, 40 and 41 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In particular, the Examiner stated that Claim 33 is indefinite because the claim recites X<sup>10</sup> being arginine, which is not indicated in the independent claim, Claim 29. Applicant has amended Claim 33 to delete "arginine" from the Markush group for X<sup>10</sup>. Such a deletion does not add new matter to the present application. In view of the amendment to Claim 33, Applicant submits that Claim 33 is definite.

The Examiner also stated that Claim 38 is indefinite because the claim recites the peptide being SEQ ID NO:34 containing citrulline as X<sup>6</sup>, which is not indicated in the independent claim, Claim 29. Applicant has submitted a corrected Sequence Listing with the present paper, correcting SEQ ID NO:34. SEQ ID NO:34 contains a D-citrulline as X<sup>6</sup>, as reflected in the specification as originally filed on page 29, Tables 5 and 6 which both identify sequence 34 as having a D-citrulline at the X<sup>6</sup> position. As a result, Claim 38 now refers to a compound containing D-citrulline as X<sup>6</sup>, which is indicated in the definition of as X<sup>6</sup> in the independent Claim 29, from which Claim 38 depends. In view of the amendment to correct the Sequence Listing, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 38 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 40-41 were rejected as indefinite as to how the compound able to bind MCH-1R was identified, since the claim only recited the step of measuring the activity of the compound to inhibit binding of the peptide to MCH1R, it did not indicate how the compound able to bind MCH-1R is identified. Claim 41 was included in the rejection because it is dependent on a rejected claim and does not correct the deficiency of the claim from which it depends.

Applicant has amended Claim 40, from which Claim 41 directly depends, to specify that the peptide is a detectably labeled peptide of Claim 29 and that the compound is identified by measuring

the ability of the compound to inhibit the binding of the labeled peptide by measuring the change in detectable label.

In view of the amendment to Claim 40, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 40 and 41 under 35 U.S.C. § 112, second paragraph, as being indefinite.

In view of the correction of the Sequence Listing, the amendment of Claims 33 and 40, and the remarks above, Applicant respectfully request reconsideration and withdrawal of the rejection of Claims 33, 38, 40 and 41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

#### **V. Claim Rejections – Obviousness Type Double Patenting**

Claims 29-32, 34-38, 40 and 41 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-25, 28-30, 34, 36, 37, and 42-43 of co-pending Application No. 10/182,509 "the '509 application."

A Notice of Allowance has been received in the '509 application, and the final fee has been paid. Without acquiescing to any obviousness over the cited claims, Applicant agrees to file a Terminal Disclaimer in the present application when the Examiner has determined that the claims are otherwise allowable except for the obviousness-type double patenting rejection over '509. This agreement to file a terminal disclaimer is being made to efficiently move the present application to patent.

#### **VI. Conclusion**

Reconsideration of the present application and entry of the amendment above is respectfully requested.

Applicant respectfully contends that the application is allowable, and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

By

A handwritten signature in black ink, appearing to read "Catherine D. Fitch", written over a horizontal line.

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Enclosures:  
Seq. Listing  
Seq. Listing Statement